

REMARKS

1. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the amendments and discussion that follows. Claims 1-58 are pending in this application.

Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,018,749 to Rivette et al. ("the Rivette '749 patent"). Claims 5, 19, 20, 29 and 48 have been rejected under 35 U.S.C. §103(a) as being obvious over the Rivette '749 patent in view of U.S. Pat. No. 5,806,079 to Rivette et al. ("the Rivette '079 patent"). Claims 39-41 and 53 have been rejected under 35 U.S.C. §103(a) as being obvious over the Rivette '749 patent in view of U.S. Pat. No. 5,241,671 to Reed et al. Claim 54 has been rejected under 35 U.S.C. §103(a) as being obvious over the Rivette '749 patent. Claims 1-10, 29, 44, 46-51 and 57 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. After a careful review of the claims (as amended), it has been concluded that the rejections are in error and the rejections are, therefore, traversed.

2. Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 have been rejected as being anticipated by the Rivette '749 patent. In response, independent claims 1 and 44 have been further limited to "a visual reference disposed on the physical page in the first window that identifies information on a portion of the at least one physical page". Support for the further limitations is provided in FIG. 3 of the specification which clearly shows the visual reference 191 disposed on the physical page in the first

window 194 that identifies information on a portion of the at least one physical page.

Claim 46 has been further limited to "an electronic page view that displays a graphic image of a physical page of the physical pages with an annotation of the annotations displayed on the physical page to identify a bounded portion of the physical page". Support for the further limitations is provided in FIG. 3 of the specification which clearly shows the an electronic page view 194 that displays a graphic image of a physical page of the physical pages with an annotation 191 of the annotations displayed on the physical page to identify a bounded portion of the physical page. Pages 10-11 of the specification describe the electronic page views 194 and markup annotations 191.

Claim 57 has also been further limited to a visual display that displays an electronic page view of a physical page". Support for the additional limitations may be found in FIG. 3 which shows the electronic page view 194 and on page 10 of the specification which describes the electronic page view 194.

Claim 57 has also been further limited to "a software portion for showing the page description format in the electronic page view where a portion of the electronic page view is identified in the electronic page view and electronic information of the identified portion is shown in the enhanced interactive window so that the electronic information shown in the enhanced interactive window is free flowing without interruption and presented dynamically depending upon a column width of the visual display, said software portion also being adapted to provide a visual reference on a portion of the page description format that

identifies corresponding information shown on the enhanced interactive window". The additional limitations are supported by the fact that "the present invention is provided as software" (specification, page 8). Support is also provided in FIG. 3 which shows the page description format (pdf) in the electronic page view 194 where a portion (identified by reference number 191) of the electronic page view 194 is identified in the electronic page view and electronic information of the identified portion is shown in the enhanced interactive window 182. Page 10 of the specification describes the electronic page view 194 and visual reference 191 that identifies the portion.

In contrast, the Rivette '749 patent fails to provide a visual reference 191 disposed on the physical page in the first window that identifies information on a portion of the at least one physical page. The use of the visual reference 191 that identifies information on a portion of the physical page provides an important aspect of the claimed invention that is not taught or suggested by the Rivette '749 patent.

In addition, the Rivette '749 patent fails to provide any teaching or suggestion of the display of a physical page. For example, "As used herein, 'physical page' is defined as a piece of paper that has top, bottom and side margins" (specification, page 6). Since FIG. 59 of the Rivette '749 patent does not show a bottom margin, FIG. 59 does not show a physical page.

Since the Rivette '749 patent does not have a visual reference or use physical pages, the Rivette '749 patent does not do the same or any similar thing as that of the claimed invention. Since the Rivette '749 does not do the

same or any similar thing as that of the claimed invention, the rejections are improper and should be withdrawn.

3. Claims 5, 19, 20, 29 and 48 have been rejected as being obvious over the Rivette '749 patent in view of the Rivette '079 patent. However, the Rivette '079 patent also fails to provide any teaching or suggestion of a visual reference within a portion of the source document. Since the Rivette '079 patent fails to provide any teaching or suggestion of the use of a visual reference, the combination of the Rivette '749 and Rivette '079 patents fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

4. Claims 39-41 and 53 have been rejected as being obvious over the Rivette '749 patent in view of Reed et al. However, the Reed et al. patent also fails to provide any teaching or suggestion of a visual reference within a portion of the source document. Since the combination of the Rivette '749 patent and Reed et al. fails to provide any teaching or suggestion of the use of a visual reference, the combination of the Rivette '749 and Reed et al. patents fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

5. Claim 54 has been rejected as being obvious over the Rivette '749 patent. However, as demonstrated above, the Rivette '749 patent fails to teach or suggest the use of a

visual reference or a physical page. Since the Rivette '749 patent fails to teach or suggest the use of a visual reference and physical page, the Rivette '749 patent fails to teach or suggest each and every claim limitation. Since the Rivette '749 patent fails to teach or suggest each and every claim limitation, the rejection is improper and should be withdrawn.

6. Claims 1-10, 29, 44, 46-51 and 57 have been provisionally rejected based upon copending application number 10/691,927 under the judicially created doctrine of obviousness-type double patenting. It may be noted first in this regard that application number 10/691,927 was filed on October 27, 2003 with an earliest priority date of October 23, 2002. In contrast, the instant application was filed on December 15, 2000 with an earliest priority date of September 28, 2000. As such, the instant application predates the cited application. Since the instant application predates the cited application, the rejection is improper and should be withdrawn.

7. Allowance of claims 1-58, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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